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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,360	08/27/2001	Jeff M. Anderson	10018309-1	5091

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

VU, TUAN A

ART UNIT	PAPER NUMBER
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2193

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,360

Applicant(s)

ANDERSON ET AL.

Examiner

Tuan A. Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the Applicant's response filed 9/16/2005.

As indicated in Applicant's response, claims 1, 2, 7, 13 have been amended and claims 16-20 canceled. Claims 1-15 are pending in the office action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 7, and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 13 recite 'suppressing an automatic installation mode for the device initiated by an operating system of the computer, upon the device being connected to the computer prior to the software being completely installed on the computer, by detecting and closing a window related to the automatic installation mode faster than a user is capable of perceiving the window'. This limitation as to closing a window faster than a user is capable of perceiving is not disclosed in the specifications in convincing terms. Specifically, the disclosure shows:

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‘...The window is created, detected, and closed preferably faster than the user can perceive the window on the display, such that preferably the user at most sees on the display a quick flash of the window being created and then closed’ (pg. 11, 2nd para)

“...it is preferably to only close ... hardware-first installation mode...” (pg. 12, first para)

‘If the user prematurely plugs... the new window created by automatic installation mode ... quickly closed’ (pg. 13, 1st para)

The term ‘preferably’ does not establish a certainty that a feature actually exists and that the invention possesses the achievement of the feature, that is, ‘faster than ... user can perceive ...’. Besides the limitation as claimed ‘faster than ... can perceive’ is not expressing in terms so to enable one skill in the art to construe how this degree of being ‘faster ...than’ amounts to, since this is a relative degree with respect to individual perception; nor does it express clear teaching about the nature of the perception in question or about the subject responsible of the act of closing. And all this renders the non-convincing aspect of the feature claimed above. More importantly, in light of this *preferable* characteristic, one skill in the art is lead to interpreting that the degree of achievement of the above limitation is very limited or at best partial. Whereas the claim does not recite this limitation in proportion with the extent of what is described in the specifications as pointed out above, it is believed that the specifications fail to support the claimed limitation above. Hence, this limitation would be considered with more open interpretation in light of this lack of disclosure.

One of which interpretation is that the closing of this window is happening very fast and that in only in very limited occasions would the user facing this closing process not have time to perceive the window, i.e. in the majority of occasions the window can still be perceived upon its

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closing; another is that the software after being commanded to take away of installation window closes the window out very fast.

Claim 7 also recites this same limitation about closing a window in 'closed faster than a user is capable of perceiving the new window'. When the specifications only describe this scenario about how fast the closing is, only a wishful degree of achievement is disclosed not a factual and established degree of achievement as explained above. Claim 7 is rejected for the same reasons as above for not reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 7, 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims 1, 7 and 13 recite 'faster than a user is capable of perceiving ... window'; there is lack of definite teaching from what is recited by 'faster than' because of a degree of relativity which is left open for interpretation; and that there is also indefiniteness in terms of the nature of this closing act or that of the agent performing the closing; or nature of the perception (visual or sensorial or mental). Thus there is insufficient clarity as to the metes and bound of the limitation when recited is a combination of an undefined type of perception, a undefined degree of something being faster than something else (faster with respect to what based on what criteria); and unspecific act or type of closing. Broad interpretation will be used to construe this limitation and this has been set forth above.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fida International, "ProLink Hurricane 8000 ADSL Modem", *User's Manual*, VER. 1.5, 2000, pp. P1-P26 (hereinafter Fida) in view of Polycom, "ViaVideo User's Guide", *ViaVideo QuickStart*, Nov. 2000, (hereinafter Polycom).

As per claim 1, Fida discloses a method for installing software on a computer for a device to be connected to the computer and while installing the software, suppressing an automatic mode for the device initiated by an operating system of the computer upon the device being connected to the computer prior to the software being completely installed thereon, by detecting and closing a window related to the automatic installation mode faster than a user is capable of perceiving the window (e.g. *CANCEL* – section 3.1.1 pg. P7 -- Note: the underlying software that takes away a *CANCEL* button reads on closing faster than a user can perceive the window); and

But Fida does not disclose instructing a user to connect the device to the computer after installing the software. The activation of a device being connected to the computer after installation of its pertaining software as disclosed by Fida suggests the motivation to ensure that the hardware device be connected in order for the installation to fully succeed and the device to get activated. Polycom, in a installation method of device being connected to a computer

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analogous to Fida wherein device driver or software components have to be installed first, discloses instructing the user to connect the device after the software has been installed (e.g. Installing Hardware - pg. 2). It would have been obvious for one of ordinary skill in the art at the time the invention was made to provide to the installation process by Fida so that there is a provision requesting the user to connect the device after the step of installing the drivers is completed because the purpose is to prepare those drivers for the device to be properly installed/activated; and it is necessary that the user ensure that the device for which the driver is intended be connected for the installation to achieve such purpose.

As per claim 2, Fida discloses the user manually initiating (e.g. steps 1, 2, 3 – section 3.1.2 P10

As per claim 3, Fida discloses inserting of a media (e.g. step 2, section 3.1.1 or step 2, sec 3.1.2)

As per claim 4, Fida discloses detecting a window, whether it is related to installation, related to automated mode, and closing the window (e.g. *CANCEL* – section 3.1.1 pg. P7)

As per claim 5, Fida discloses initiation of installation mode (re claim 1); and also re-enumeration routine of the computer system (e.g. P14, P16 Note: initiating the re-enumeration process via Plug-and-Play and enumeration data displayed to user thereafter as a result of the execution of such initiating step amounts to initiating installation mode by inherently calling re-enumeration routines).

As per claim 6, in view of the teachings by Polygon's using a GUI installation with interactive type buttons waiting for mouse-click events, this waiting for the user to confirm would have been obvious for the same grounds as set forth in claim 1.

As per claim 7, Fida discloses a computer medium with computer instructions to perform a method comprising:

installing software for a device to be connected to a computer (e.g. section 3.1 p. P6) and while installing the software,

detecting a window and determining whether it is related to automatic mode of installation, and closing the window by detecting and closing a window related to the automatic installation mode faster than a user is capable of perceiving the window (e.g. *CANCEL* – section 3.1.1 pg. P7 -- Note: the underlying software that takes away a CANCEL button reads on closing faster than a user can perceive the window)

As per claims 8-10, the steps of associating variables or attribute to a button due to OS automatic detection of device within a window, such window having OS attributed handle, or some string identification imparted to such handle; and setting an countermanding action (a flag) upon the detection of such identification are all features inherent to Windows operating system and underlying process for identifying components and their handles; therefore the detecting of window with CANCEL button as disclosed by Fida implicitly disclose the attribute, string resources, a flag identifying a automatic mode of claims 8-10.

As per claim 11, Fida discloses re-initiate the installation by detecting a CANCEL button (*CANCEL* – section 3.1.1 pg. P7) with its inherent window handle associating with a click on the CANCEL button; and also discloses a plug-and-play mode wherein automatic mode of installation keeps on proceeding (section 3.1.2), hence has disclosed appropriate action based on the window flag (plug-and-play flag versus automatic mode flag) as addressed in claim 10.

As per claim 12, refer to claim 5.

As per claim 13, Fida discloses a point of sale device package comprising: a device to be connected to a computer via a connector of the device coupling to a corresponding connector of the computer (sec 2.1 – pg. P4) and means for suppressing an automatic mode for the device initiated by an operating system of the computer upon the device being connected to the computer prior to the software being completely installed thereon, by detecting and closing a window related to the automatic installation mode faster than a user is capable of perceiving the window (e.g. *CANCEL* – section 3.1.1 pg. P7 -- Note: the underlying software that takes away a *CANCEL* button reads on closing faster than a user can perceive the window).

As per claim 14, Fida discloses a communication device (sec 2.1 – pg. P4 – Note: Modem being able to act as an signal processor for phone, PC, or a router is equivalent to a multi-function device); whereas Polygon discloses a camera (ViaVideo), both requiring USB port and installation of software first. It would have been obvious to combine the teachings of Fida and Polygon so that the device can also be a camera with the same benefits as taught from the rationale used in claim 1; because the more devices an invention can apply to the more marketable the product becomes.

As per claim 15, Fida discloses USB and IEEE-1394 (e.g. sec 2.1 – pg. P4 – Note: Modem and IEEE-1394 were inter-compatible technologies at the time the invention was made).

Response to Arguments

7. Applicant's arguments filed 9/16/2005 have been fully considered but they are not persuasive. Following are the Examiner's observation thereto.

Claim rejections under 35 USC 103:

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(A) Applicants have submitted that Fida in view of Polycom does not disclose the suppression of an automatic installation mode by detecting and closing a window related to the automatic installation mode faster than a user is capable of perceiving the window (Appl. Rmrks, pg. 6, bottom, pg. 7, top). The limitation recited as 'faster than a user is capable of perceiving the window' is not disclosed sufficiently in the disclosure or in the claims to enable how this suppression as recited can be implemented or made use of by a skill in the art in light of what is disclosed in the specifications; and this deficiency has been put forth in the above USC 112, 1st para rejection. Since, the claimed feature does not set any specific teaching how this closing action as to being faster than perceived, the construction of the feature has to be relied on the specifications; and it has been determined that even the specifications does not provide solid teachings as to how this very fast window closing effect on the user is achieved when this effect is recited as 'preferable'. The limitation therefore has been interpreted based on most reasonable and broad construction in light of the skill level in the art of the examiner. That is, in view of the indefiniteness from the USC 112, 2nd paragraph and the deficiency as set forth in the USC 112, 1st paragraph rejection, the recited limitation specification about how fast this closing is has been interpreted on broad grounds and thus found as being disclosed by Fida's software closing process as proffered in the rejection. And as mentioned in the USC 112, 2nd para rejection, this '...faster than ... perceive the window' has been construed or treated as the automated aspect of the underlying execution code triggered to take away a window widget when such widget is suppressed from the installation screen interface. And such rationale is based upon the lack of definiteness of what the nature of the closing act or that of the agent performing the closing, the

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relative degree of being perceived (e.g. how fast is this closing to be perceived with respect to who?), and the nature of the perception.

(B) Applicants have submitted that Fida in view of Polycom does not disclose or render obvious the suppression as claimed (Appl. Rmrks, pg. 8, middle) because Fida's user inherently and necessarily 'perceives' the window. These arguments fall under the assumption that the "...faster than ... perceive the window' limitation as claimed has some weight and that it is clearly supported by the invention specifications. And this is not true by virtue of the 35 USC 112 rejections from above; that is, disclosing that a feature would be accomplished as a preferable alternative does not signify that the feature is under possession by the invention; and it appears that the claim does not take this into count, i.e. by asserting that the so-called preferably achieved feature is for real and otherwise possessed by the inventor; hence the argument is improperly for being founded on a feature not sufficiently disclosed. Hence, these arguments are not persuasive in light of the rationale as set forth in section A above.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan A Vu whose telephone number is (272) 272-3735. The examiner can normally be reached on 8AM-4:30PM/Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571)272-3719.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-3735 (for non-official correspondence – please consult Examiner before


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using) or 571-273-8300 (for official correspondence) or redirected to customer service at 571-272-3609.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VAT
September 29, 2005


KAKALI CHAKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100